

## Remarks

This amendment does not result in an increase in the total number of claims pending or in an increase in the number of independent claims pending. And, this amendment is being filed within the period set for response to the outstanding office action. Accordingly, no additional fees are necessitated by this amendment.

### For the Claims:

Applicant submitted claims 1-20, of which claims 1, 11, and 20 are independent claims. This Office Action rejects claims 1-20, i.e., all claims. Applicant hereby amends claim 9 and retains claims 1-8 and 10-20 as originally and previously submitted. Applicant respectfully requests reconsideration.

This Office Action rejects claims 1-9, 11-17, and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Palestrant, U.S. Patent No. 5,921,468 (hereinafter Palestrant '468) in view of Kennedy et al., U.S. Patent No. 4,721,250 (hereinafter Kennedy) and further in view of Sandvik, U.S. Patent No. 4,801,091 (hereinafter Sandvik).

With regard to independent claims 1, 11, and 20, this Office Action asserts that Palestrant '468 teaches an atomizing nozzle and method of making same, which nozzle has a nozzle body encompassing a fluid chamber and an impeller residing within that fluid chamber. This Office Action acknowledges that Palestrant '468 fails to teach a metallic orifice insert, but asserts that Kennedy teaches a metallic orifice insert affixed to a nozzle body, and that it would have been obvious to combine the teachings of Kennedy with those of Palestrant '468. This Office

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Action also acknowledges that neither Palestrant '468 nor Kennedy teaches a preferred material for nozzle components, but that Sandvik teaches a showerhead for use in various environments where the nozzle body can be manufactured of anodized aluminum, and that it would have been obvious to combine the teachings of Sandvik with those of Palestrant '468 and Kennedy. This Office Action further asserts that it would be an obvious design choice to select desired materials for the nozzle body and the orifice insert, and cites *In re Leshin*, 125 USPQ 416.

Sandvik teaches in the art of shower nozzles, not in the art of atomizing nozzles. These arts are different in kind. That is, the problems of one are not the problems of the other.

Shower nozzles are configured to break water into streams intended to wet whoever or whatever is under the nozzle. Even in fancier shower heads with rotating components or other devices to break up the streams of water, the streams are made to pulsate or otherwise stream intermittently. The streams of water, however, remain streams of water. There is no intent that the streams of water not wet whoever or whatever is under the nozzle. Quite the contrary, wetting whoever or whatever is under the nozzle is their primary intent. This includes so-called fine spray heads, e.g., those used in the produce sections of grocery stores.

Atomizing nozzles are configured to fracture water into a mist or fog of fine droplets, which mist is intended to rapidly evaporate and cool the surrounding atmosphere. The intent of atomizing nozzles is to avoid wetting whoever or whatever is under the atomizing nozzle. In point of fact, if an atomizing nozzle were to wet whoever or whatever is under it, it would not be properly fulfilling its intended purpose.

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The difference is far greater than mere semantics. The inherent design and structure of the two devices are radically different. Among these differences is the size of the exit orifices. Shower orifices are of a size sufficiently large that the oxidation problems of aluminum, discussed in Applicant's Specification in paragraphs [0007] and [0008], become irrelevant. Aluminum is therefore well known in the art of shower nozzles. Until applicant's invention as claimed in claims 1, 11, and 20, aluminum was believed to be unacceptable for use in atomizing nozzles for the reasons set forth in Applicant's Specification in paragraphs [0007] through [0012]. Applicant's invention as claimed in claims 1, 11, and 20 is for a structure that moves against the accepted wisdom in the art of atomizing nozzles.

Since the shower nozzle of Sandvik does not address the problems faced by atomizing nozzles and has an entirely different intent (e.g., wetting the person under the shower nozzle versus complete evaporation to maximize cooling and to prevent the person under the atomizing nozzle from getting wet), Sandvik is improperly combined with Palestrant '468 and/or Kennedy. Long standing patent law demands that the problems addressed by references be evaluated. As stated in *In re Shaffer*, 108 USPQ 326 at 329 (CCPA 1956):

In fact, a person having the reference before him who was not cognizant of appellant's disclosure would not be informed that the problem solved by appellant ever existed. Therefor, can it be said that these references which never recognized appellant's problem would have suggested its solution? We think not, and therefore feel that the references were improperly combined since there is not suggestion in either of these references that they can be combined to produce appellant's result.

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According to long standing patent law, Sandvik, does not teach in the proper art, and is therefore not proper prior art against the present invention.

Regarding patentability, *In re Leshin*, 125 USPQ 416, states:

1. Patentability -- Change -- Material (§51.257)

Mere selection of known plastics to make container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on basis of suitability for intended use, is obvious.

That is, *In re Leshin* states that it would be obvious to use a material known in the prior art for the area of technology to which the invention relates (i.e., plastic container-dispensers for Leshin or atomizing nozzles for the Applicant's invention as claimed in independent claims 1, 11, and 20). However, the use of aluminum for a nozzle body was not known in the art of atomizing nozzles (misting heads) prior to the present invention. In paragraphs [0007]-[0009] and [0011]-[0012] of the Specification, the use of aluminum is specifically pointed out as an existing problem that the present invention seeks to overcome.

Since the use of aluminum for a nozzle body was not known in the art of atomizing nozzles prior to the present invention, *In re Leshin* reinforces the non-obviousness of the use of aluminum.

MPEP 706.02(j) and MPEP 2143 set forth the three basic criteria for making a *prima facie* case of obviousness, as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must

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be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

There is strong suggestion in the art of atomizing nozzles to avoid the use of aluminum. Because the use of aluminum in atomizing nozzles has heretofore been shunned, of course there is no suggestion in atomizing nozzle art references of Palestrant '468 or Kennedy, either severally or in combination, to use aluminum for the nozzle body. The mere discovery of a reference from a different art (e.g., Sandvik from the art of shower nozzles) which does not experience the fog- or mist-producing problems of the atomizing-nozzle art but nevertheless teaches the use of aluminum fails to make a *prima facie* case of obviousness. As stated in the MPEP and discussed above, a suggestion to make the combination and a reasonable expectation of success must be found in the prior art. None of the Palestrant '468, Kennedy, or Sandvik references, severally or in combination, suggests that the use of aluminum has a reasonable expectation of success in an atomizing nozzle application. Thus, it is not obvious under MPEP 706.02(j) and MPEP 2143 to use aluminum for an atomizing nozzle body. This is affirmed in *In re Gordon et al.*, 221 USPQ 1125 at 1127 (Fed. Cir. 1984) and repeated in *In re Laskowski*, 10 USPQ 1397 at 1398 (Fed. Cir. 1989):

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

That this is a firmly established principle is further affirmed in *Ex parte Levengood*, 28 USPQ 2d 1300, 1301-02 (B.P.A.I. 1993):

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The examiner notes that each reference discloses a different aspect of the claimed process. The examiner also notes that all aspects were "well known in the art." The examiner then indicates that because the various aspects of the claimed process were individually known in the art, the modification of the electrophoretic process of Levengood by exposing Levengood's plant materials to cell-associated materials in order to "graft" or otherwise incorporate the cell associated material into the plants was "well within the ordinary skill of the art at the time the claimed invention was made."

We reverse the rejection because the examiner has used the wrong standard of obviousness.... At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness.... That which is within the capabilities of one skilled in the art is not synonymous with obviousness.... That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention....

Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.

Palestrant '468, Kennedy, and Sandvik, either severally or in combination, fail to teach or suggest the use of an aluminum atomizing nozzle body, anodized or not. Neither is it known by those of ordinary skill in the art to use aluminum for an atomizing nozzle body. Independent claims 1, 11, and 20 are believed to be allowable as originally submitted under 35 U.S.C. 103(a) over Palestrant '468 in view of Kennedy and further in view of Sandvik. The applicant respectfully requests reconsideration of independent claims 1, 11, and 20.

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With regard to claims 2-9, 12-17, and 19, claims 2-9 depend, either directly or indirectly, from independent claim 1, and claims 12-17 and 19 depend, either directly or indirectly, from independent claim 11. Applicant has amended claim 9 to correct a minor grammatical/typographical error having no impact upon subject matter. Inasmuch as independent claims 1 and 11 are believed to be allowable for the reasons discussed hereinbefore, claims 2-9, 12-17, and 19 are believed to be allowable as originally or previously submitted or currently amended by reason of dependency. The applicant respectfully requests reconsideration of claims 2-9, 12-17, and 19.

This Office Action rejects claims 10 and 18 under 35 U.S.C. 103(a) as being unpatentable over Palestrant '468 in view of Kennedy, further in view of Sandvik, and further in view of Palestrant, U.S. Patent No. 6,283,387 (hereinafter Palestrant '387).

With regard to claims 10 and 18, claim 10 depends directly from independent claim 1, and claim 18 depends directly from independent claim 11. Inasmuch as independent claims 1 and 11 are believed to be allowable for the reasons discussed hereinbefore, claims 10 and 18 are believed to be allowable as originally or previously submitted by reason of dependency. The applicant respectfully requests reconsideration of claims 10 and 18.

Accordingly, this Amendment amends claim 9. Currently amended claim 9 remains in the application and is believed to be allowable. In addition, claims 1-8 and 10-20 remain in the application as originally and previously submitted and are believed to be allowable.

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Applicant believes that the foregoing amendments and remarks are fully responsive to the rejections and/or objections recited in the 28 January 2008 Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration of the present application is respectfully requested.

Respectfully submitted,



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